U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

APPEAL BRIEF TRANSMITTAL		Docket Number: **10191/3242**	Conf. No. **2648**
Application Number **09/819,788**	Filing Date **March 28, 2001**	Examiner **Huy Thanh NGUYEN**	Art Unit **2616**
Invention Title **MULTI-VIDEO DEVICE CONTROL AND EXPANSION METHOD AND APPARATUS**		Inventor **Daniel REESE et al.**	

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Commissioner for Patents
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Date: December 21, 2006 Reg. No. 36,197

Signature: _____
Jong H. Lee

Further to the Notice of Appeal dated October 20, 2006 (received at the PTO on October 24, 2006) for the above-referenced application, enclosed are three copies of an Appeal Brief.

The Commissioner is hereby authorized to charge payment of the 37 C.F.R. § 41.20(b)(2) appeal brief filing fee of **$500**, and any additional fees associated with this communication, to the deposit account of **Kenyon & Kenyon LLP**, deposit account number **11–0600**.

(R. No. 36,197)

Dated: December 21, 2006

By: JONG LEE for Gerard Messina
Gerard A. Messina (Reg. No. 35,952)
KENYON & KENYON LLP
One Broadway
New York, N.Y. 10004
(212) 425-7200
CUSTOMER NO. 26646
PATENT & TRADEMARK OFFICE

[10191/3242]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s)	:	Daniel REESE et al.
Serial No.	:	09/819,788
Filed	:	March 28, 2001
For	:	MULTI-VIDEO DEVICE CONTROL AND EXPANSION METHOD AND APPARATUS
Examiner	:	Huy Thanh NGUYEN
Art Unit	:	2616
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APPELLANTS' APPEAL BRIEF
UNDER 37 C.F.R. § 41.37

S I R :

Applicants filed a Notice of Appeal dated October 20, 2006 (received at the PTO on October 24, 2006), appealing from the Final Office Action dated April 20, 2006, in which claims 1-20 of the above-identified application were finally rejected. This Brief is submitted by Applicants in support of their appeal.

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I. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Robert Bosch GmbH of Stuttgart, Germany. Robert Bosch GmbH is the assignee of the entire right, title, and interest in the present application.

II. RELATED APPEALS AND INTERFERENCES

No appeal or interference which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal is known to exist to the undersigned attorney or is believed by the undersigned attorney to be known to exist to Applicants.

III. STATUS OF CLAIMS

Claims 1-20 are pending in the present application, and all of the pending claims are being appealed. Among the appealed claims, claims 1, 12 and 17 are independent. Claims 2-11 ultimately depend on claim 1; claims 13-16 ultimately depend on claim 12; and claims 18-20 ultimately depend on claim 17.

IV. STATUS OF AMENDMENTS

No amendment has been made subsequent to the final Office Action mailed on April 20, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

With respect to independent claim 1, the present invention provides a digital video recorder-controller apparatus (DVRC) (Fig. 1 – DVRC-1 . . . DVRC-N) including:

a network port (Fig. 2 – "Network Port" adjacent to ethernet controller 241) for communicatively connecting the DVRC with at least one other apparatus on a network; (Specification, p. 4, l. 17);

wherein the DVRC is adapted to transmit through the network port (Fig. 2 – "Network Port" adjacent to ethernet controller 241) a first selection of digitized video signals, wherein the

first selection includes one or more digitized video signals being transmitted to a first other apparatus on the network; (Specification, p. 2, l. 13-16; p. 7, l. 16-19; p. 11, l. 5-12);

and wherein the DVRC is further adapted to receive through the network port (Fig. 2 – "Network Port" adjacent to ethernet controller 241) a second selection of digitized video signals, wherein the second selection includes one or more digitized video signals being transmitted by a second other apparatus on the network; (Specification, p. 2, l. 16-19; p. 11, l. 5-12);

wherein the DVRC is adapted to facilitate designation of the digitized video signals of the second selection. (Specification, p. 2, l. 20-21; p. 11, l. 1-12).

With respect to independent claim 12, the present invention provides a digital video system including:

a network; (Fig. 1 - ethernet network; p. 5, l. 9);

a first plurality of video cameras (Fig. 1 – elements 310) operatively connected to a digital video recorder-controller apparatus (DVRC) (Fig. 1 – DVRC-1) on the network, the DVRC having:

a first network port (Fig. 2 – "Network Port" adjacent to ethernet controller 241) for communicatively connecting the DVRC with at least one other apparatus on the network; (Specification, p. 4, l. 17);

a first plurality of video-out ports (Fig. 2 – M video-out ports) adapted to facilitate the display of one or more video signals on one or more DVRC monitors; (Specification, p. 8, l. 1-8);

wherein the DVRC is adapted to receive through the first network port (Fig. 2 – "Network Port" adjacent to ethernet controller 241) a first selection of digitized video signals including one or more digitized video signals transmitted by a first other apparatus on the network; (Specification, p. 2, l. 16-19; p. 11, l. 5-12); and

a second plurality of video cameras (Fig. 1 – elements 310) operatively connected to a digital video recorder (DVR) on the network (Fig. 1 – DVRC-2; p. 5, l. 16-21), the DVR having:

a second plurality of video-out ports (Fig. 2 – M video-out ports) adapted to facilitate the display of one or more video signals on one or more DVR monitors; (Specification, p. 8, l. 1-8);

a second network port (Fig. 2 – "Network Port" adjacent to ethernet controller 241) for communicatively connecting the DVR with the DVRC on the network; (Specification, p. 4, l. 17);

wherein the DVR is adapted to transmit through the second network port a second selection of digitized video signals, wherein the second selection of digitized video signals includes one or more digitized video signals of the first selection of digitized video signals. (Specification, p. 2, l. 16-19; p. 8, l. 13-18; p. 9, l. 8-19; p. 11, l. 5-12).

With respect to independent claim 17, the present invention provides a method for expanding a digital video system (Fig. 1 – system 100), which method includes:

a) providing a first digital video recorder-controller apparatus (DVRC) (Fig. 1 – DVRC-1) having:

a DVRC network port; (Fig. 2 – "Network Port" adjacent to ethernet controller 241; Specification, p. 4, l. 17);

at least one control panel; (Fig. 2 – element 211; Specification, p. 13, l. 17-18);

wherein the first DVRC is adapted to receive through the DVRC network port a selection of digitized video signals; (Specification, p. 2, l. 16-19; p. 11, l. 5-12); and

a plurality of DVRC video-out ports (Fig. 2 – M video-out ports) adapted to facilitate the display of one or more video signals on one or more video monitors. (Specification, p. 8, l. 1-8).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review on appeal in this case:

(A) Whether pending claims 1-6, 10-11 and 17-18 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,963,995 ("Lang").

(B) Whether claim 7 is unpatentable under 35 U.S.C. § 103(a) over Lang in view of U.S. Patent No. 5,930,473 ("Teng").

(C) Whether claims 8 and 9 are unpatentable under 35 U.S.C. § 103(a) over Lang in view of U.S. Patent No. 5,666,363 ("Osakabe").

(D) Whether claims 12-16 are unpatentable under 35 U.S.C. § 103(a) over Lang in view of U.S. Patent No. 6,330,025 ("Arazi").

(E) Whether claim 19 is unpatentable under 35 U.S.C. § 103(a) over Lang in view of U.S. Patent No. 6,330,025 ("Arazi").

(F) Whether claim 20 is unpatentable under 35 U.S.C. § 103(a) over Lang in view of Arazi, and further in view of U.S. Patent 5,666,363 ("Osakabe").

VII. ARGUMENTS

A. Rejection of Claims 1-6, 10-11 and 17-18 under 35 U.S.C. § 102(b)

Claims 1-6, 10-11 and 17-18 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,963,995 ("Lang").

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Independent claim 1 recites, in relevant parts, "a network port for communicatively connecting the DVRC with at least one other apparatus on a network"; "the DVRC is further adapted to receive through the network port a second selection of digitized video signals, wherein the second selection includes one or more digitized video signals being transmitted by a second other apparatus on the network"; and "the DVRC is adapted to facilitate designation of the digitized video signals of the second selection."

Regarding the Examiner's assertions with respect to the teachings of Lang as applied against the rejected claim 1, Applicants note that the actual teachings of Lang do not support the Examiner's contentions. In the "Response to Arguments" section of the final Office Action, the Examiner contends that Lang teaches a network port for the DVRC since "Lang

teaches the apparatus and another apparatus are in a network since the apparatus and another apparatus can communicate, receive and transmit the digitized video signals . . . [and] the recited network port is a port for receiving or transmitting the digitized video signals . . . . (See Lang column 7, lines 30-65, and column 14, lines 54-68)." The Examiner's contentions are essentially that a network port is inherently disclosed in Lang. However, to the extent that the Examiner is relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). As explained in further detail below, the allegedly inherent characteristics simply do not necessarily flow from the teachings of the applied art.

Initially, Applicants not that the actual disclosure of Lang clearly does not explicitly teach a "network port." Furthermore, to the extent the Examiner cites element 22 of Lang as being equivalent to the claimed "network port," Lang clearly indicates that audio/video transmitter/receiver 22 is connected to a conventional telephone connection, which is in turn connected to a video recorder, (see, e.g., col. 9, l. 59-62), which necessarily means the audio/video transmitter/receiver 22 is a modem that implements a point-to-point connection to a second video recorder via a telephone line. However, the disclosure clearly does not imply that the audio/video transmitter/receiver 22 is a network port for a connection to a network.

Independent of the above, Applicants note that the Examiner's asserted interpretation of the disclosure of Lang contradicts the anticipation conclusion. In support of the rejection, the Examiner contends in paragraph 2 of the final Office Action that Lang discloses "a network port (22) for communicatively connecting the DVRC with at least one other apparatus on a network," and "the DVRC is further adapted to receive through the network port (36, 37, 35) a second selection of digitized video signals." While the Examiner cites two separate components as allegedly being equivalent to the claimed "network port" features, claim 1 clearly recites that the same network port is involved in "communicatively connecting the DVRC with at least one other apparatus" and receiving "a second selection of digitized video signals." In any case, it should be noted that connections 35, 36, 37 clearly do not represent "network ports"; instead, these components are point-to-point connections. In particular, according to column 7, lines 29 to 31 of Lang, selector switch 35 is provided for the selection of a video connection or a TV

receiver; according to column 7, lines 41 and 42 of Lang, switch 36 is provided for the selection of a video connection; and according to column 8, lines 3 to 6 of Lang, switch 37 is provided for the selection of an optical connection.

In the Advisory Action mailed on October 24, 2006, the Examiner presents a new argument which is different from the arguments presented in the final Office Action: in the Advisory Action, the Examiner contends that "Lang teaches a network port (18) using fiber optic lines and a network port (46, 22) using telephone lines for transmitting and receiving the selection of the digitized video signals . . . (column 7, lines 45-65; column 8, lines 30-57)." The newly-cited port 18 of Lang is clearly indicated as a port for interfacing audio/video signals with a fiber optic line, which once again necessarily means the audio/video port 18 implements a point-to-point connection to a second video recorder (as clearly indicated by the explicit statement that "a video program may be communicated . . . from the first VCR-ET to a second VCR-ET," (col. 7, l. 61-63)). There is simply no indication that audio/video transmitter/receiver port 18 is a network port for a connection to a network.

Independent of the above, Lang clearly does not teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., "facilitate designation of the digitized video signals of the second selection," as recited in claim 1. Although the Examiner cites col. 7, l. 30-45; col. 8, l. 30-60; and col. 9, l. 55 – col. 10, l. 5, as teaching the above-recited feature of claim 1, the cited sections of Lang do not actually teach or suggest the claimed feature. Nothing in Lang even remotely suggests that video recorder 10 controls a signal source connected via switches 35, 36, 37, let alone that any such control relates to the determination of the second selection. Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In this regard, Lang clearly does not enable a person having ordinary skill in the art to practice the claimed invention, including "facilitate designation of the digitized video signals of the second selection."

To the extent the Examiner contends in the Advisory Action that "each apparatus can facilitate designation of the digital video signals of the second selection or first selection since each apparatus has means to enable the selections of transmitting the digitized video signals and receiving the digitized video signals by using the key board and buttons on each apparatus," this assertion is not only unsupported by any disclosure in Lang, but also legally flawed to the extent

the Examiner is invoking the doctrine of inherent disclosure. The Examiner appears to be contending that the claimed feature of "facilitat[ing] designation of the digitized video signals of the second selection" is inherently disclosed in Lang since it is possible to achieve "transmitting the digitized video signals and receiving the digitized video signals by using the key board and buttons on each apparatus," but this assertion is completely flawed since Lang merely discloses a point-to-point connection rather than a network connection, and there is no "basis in fact and/or technical reasoning to reasonably support the determination" that the claimed "facilitat[ing] designation of the digitized video signals of the second selection" would necessarily have to be present even if the system of Lang were somehow presented in a network setting (which is clearly not true).

To the extent the Examiner cites col. 14, l. 54-68 of Lang for teaching "receiving a plurality of digital video programs or portions from another apparatus and transmitting a plurality of digital video programs or portions to another apparatus via a networking," the actual disclosure of the cited section does not add anything to the Examiner's anticipation argument: the cited section (claim 30) merely recites "a plurality of audio/video transceivers, coupled via one or more communication links," and that each transceiver includes "input means for receiving audio/video source information," but there is further enabling disclosure regarding the "transfer network," let alone any suggestion that a transceiver "facilitates designation of the digitized video signals of the second selection."

For at least the foregoing reasons, claim 1 and its dependent claims 2-6 and 10-11 are not anticipated by Lang. Applicants note that claim 17 recites features substantially similar to the above-discussed features of claim 1, i.e., "a DVRC network port" and "the first DVRC is adapted to receive through the DVRC network port a selection of a digitized video signals," so claim 17 and its dependent claim 18 are similarly not anticipated by Lang, at least for the reasons stated in connection with claim 1.

In view of all of the foregoing, reversal of the anticipation rejection is respectfully requested.

B. Rejection of Claim 7 under 35 U.S.C. § 103(a)

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 5,930,473 ("Teng").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First of all, claim 7 depends on claim 1. Furthermore, the teachings of Teng simply do not remedy the deficiencies of Lang as applied against parent claim 1, e.g., Teng similarly fails to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., "facilitate designation of the digitized video signals of the second selection," as recited in amended claim 1. For at least these reasons, dependent claim 7 is not rendered obvious by the combination of Lang and Teng.

C. Rejection of Claims 8 and 9 under 35 U.S.C. § 103(a)

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 5,666,363 ("Osakabe").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First of all, claims 8 and 9 ultimately depend on claim 1. Furthermore, the teachings of Osakabe simply do not remedy the deficiencies of Lang as applied against parent claim 1, e.g., Osakabe similarly fails to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., "facilitate designation of the digitized video signals of the second selection," as recited in claim 1. In addition, while the Examiner contends that col. 7, l. 15 to col. 8, l. 15 of Osakabe teaches the claimed feature that "the DVRC is further adapted to transmit a first control signal to the second other apparatus, wherein the first control signal designates the one or more video signals of the second selection of digitized video signals to be transmitted by the second other apparatus," as recited in claim 8, this claimed feature simply cannot be inferred from Osakabe. Osakabe merely discloses that a TV set 10 sends a signal to a video recorder 20, in order to cause the video recorder to rerecord video data. However, nothing in Osakabe suggests that the video recorder generates this control signal. In any case, one skilled in the art would not be motivated to combine the teachings of Osakabe with the teachings of Lang, since Lang provides no external control possibility of the video recorder via an external bus, as is required according to the approach of Osakabe using bus 1.

For at least the foregoing reasons, dependent claims 8 and 9 are not rendered obvious by the combination of Lang and Osakabe.

D. Rejection of Claims 12-16 under 35 U.S.C. § 103(a)

Claims 12-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 6,330,025 ("Arazi").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants note that claim 12 recites substantially similar features as those recited in amended claim 1. As discussed in connection with claim 1, Lang fails to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., "facilitate designation of the digitized video signals of the second selection." In addition, Lang does not teach or suggest that the DVRC has a network port. Furthermore, the teachings of Arazi simply do not remedy the deficiencies of Lang as applied against claim 12. Accordingly, any combination of Lang and Arazi would fail to approximate the invention of claim 12.

Independent of the above, Applicants note that one of ordinary skill in the art would not be motivated to combine the teachings of Arazi with the teachings of Lang, since Lang relates to a classical video recorder which is only intended for the simultaneous processing of a single data source, and Lang does not teach or suggest anything regarding the processing of several data sources (e.g., video cameras) simultaneously. Therefore, one skilled in the art would have no reason to provide a plurality of video cameras in Lang. In addition, one skilled in the art would derive no suggestion from Arazi to connect both the DVRC and the DVR to a plurality of video cameras.

For at least the foregoing reasons, claim 12 and its dependent claims 13-16 are not rendered obvious by the combination of Lang and Arazi.

E. Rejection of Claim 19 under 35 U.S.C. § 103(a)

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 6,330,025 ("Arazi").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First of all, claim 19 depends on claim 17. Applicants note that claim 17 recites features substantially similar to the above-discussed features of claim 1, i.e., "a DVRC network port" and "the first DVRC is adapted to receive through the DVRC network port a selection of a digitized video signals," so Lang fails to teach all of the features of claim 17 for the reasons stated in connection with claim 1. Furthermore, the teachings of Arazi simply do not remedy the deficiencies of Lang as applied against parent claim 17. For at least these reasons, dependent claim 19 is not rendered obvious by the combination of Lang and Arazi.

F. Rejection of Claim 20 under 35 U.S.C. § 103(a)

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of Arazi, and further in view of U.S. Patent 5,666,363 ("Osakabe").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 20 depends on claim 19, which in turn depends on claim 17. As noted above, the combination of Lang and Arazi fails to teach or suggest all of the features of claims 17 and 19. Furthermore, the teachings of Osakabe simply do not remedy the deficiencies of Lang and Arazi as applied against parent claims 17 and 19. Accordingly, even if one assumes for the sake of argument that there were some motivation to combine the teachings of the applied references in the manner asserted by the Examiner (with which conclusion Applicants do not agree), the asserted combination would fail to approximate the claimed invention of dependent claim 20. For at least these reasons, the combination of Lang, Arazi and Osakabe does not render obvious dependent claim 20.

VIII. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the final rejection of claims 1-20 should be reversed.

Claims Appendix, Evidence Appendix and Related Proceedings Appendix sections are found in the attached pages.

Respectfully submitted,

KENYON & KENYON LLP

(R. No. 36,197)

Dated: December 21, 2006

By: JONG LEE for Gerard Messina

Gerard A. Messina
Reg. No. 35,952
(212)425-7200
CUSTOMER NO. 26646
PATENT & TRADEMARK OFFICE

APPENDIX TO APPELLANTS' APPEAL BRIEF UNDER 37 C.F.R. § 41.37

CLAIMS APPENDIX

The claims involved in this appeal, claims 1-20, in their current form after entry of all amendments presented during the course of prosecution, are set forth below:

1. A digital video recorder-controller apparatus (DVRC) comprising:

a network port for communicatively connecting the DVRC with at least one other apparatus on a network;

wherein the DVRC is adapted to transmit through the network port a first selection of digitized video signals, wherein the first selection includes one or more digitized video signals being transmitted to a first other apparatus on the network;

and wherein the DVRC is further adapted to receive through the network port a second selection of digitized video signals, wherein the second selection includes one or more digitized video signals being transmitted by a second other apparatus on the network;

wherein the DVRC is adapted to facilitate designation of the digitized video signals of the second selection.

2. The DVRC of claim 1, further comprising an integrated control panel having dedicated function buttons adapted to facilitate selecting one or more video signals of the first selection and of the second selection.

3. The DVRC of claim 1 further comprising an external control port, adapted to facilitate selecting one or more video signals of the first selection and of the second selection.

4. The DVRC of claim 1, further comprising a plurality of video-out ports adapted to display one or more video signals derived from the first selection or from the second selection; and wherein the DVRC is adapted to record one or more video signals of the second selection of digitized video signals.

5. The DVRC of claim 1, wherein the first other apparatus is a second DVRC on the network.

6. The DVRC of claim 1, wherein the second other apparatus is a digital video recorder (DVR).

7. The DVRC of claim 1, wherein the network port is an ethernet port.

8. The DVRC of claim 1, wherein the DVRC is further adapted to transmit a first control signal to the second other apparatus, wherein the first control signal designates the one or more video signals of the second selection of digitized video signals to be transmitted by the second other apparatus.

9. The DVRC of claim 8, wherein the second other apparatus is a second DVRC operating in slave-mode on the network.

10. The DVRC of claim 1, further comprising a plurality of Analog video-in ports for receiving one or more video signals to be digitized to become one or more digitized video signals.

11. The DVRC of claim 1, further comprising at least one digital video-in port, for receiving one or more digitized video signals.

12. A digital video system comprising:

a network;

a first plurality of video cameras operatively connected to a digital video recorder-controller apparatus (DVRC) on the network, the DVRC having:

a first network port for communicatively connecting the DVRC with at least one other apparatus on the network;

a first plurality of video-out ports adapted to facilitate the display of one or more video signals on one or more DVRC monitors;

wherein the DVRC is adapted to receive through the first network port a first selection of digitized video signals including one or more digitized video signals transmitted by a first other apparatus on the network; and

a second plurality of video cameras operatively connected to a digital video recorder (DVR) on the network, the DVR having:

a second plurality of video-out ports adapted to facilitate the display of one or more video signals on one or more DVR monitors;

a second network port for communicatively connecting the DVR with the DVRC on the network;

wherein the DVR is adapted to transmit through the second network port a second selection of digitized video signals, wherein the second selection of digitized video signals includes one or more digitized video signals of the first selection of digitized video signals.

13. The digital video recording system of claim 12, wherein at least one video camera of the first plurality of video cameras is an Analog video camera, and at least one video camera of the second plurality of video cameras is an Analog video camera.

14. The digital video system of claim 13, wherein the DVR is the first other apparatus on the network.

15. The digital video system of claim 14, wherein the DVRC is adapted to output through the DVRC's first plurality of video-out ports one or more of the digitized video signals of the second selection of digitized video signals.

16. The digital video system of claim 14, wherein the DVRC is adapted to record and store one or more of the digitized video signals of the second selection of digitized video signals.

17. A method for expanding a digital video system comprising:

a) providing a first digital video recorder-controller apparatus (DVRC) having:

a DVRC network port;

at least one control panel;

wherein the first DVRC is adapted to receive through the DVRC network port a selection of digitized video signals; and

a plurality of DVRC video-out ports adapted to facilitate the display of one or more video signals on one or more video monitors.

18. The method claim 17, wherein providing a DVRC includes modifying internal software of a DVR.

19. The method of claim 17, further comprising:

b) providing a network and connecting the first DVRC to the network; and

c) connecting a digital video recorder (DVR) to the network, the DVR having;

a plurality of DVR video-in ports, for receiving video signals from video cameras;

a DVR network port;

wherein the DVR is adapted to transmit through the DVR network port a DVR selection of digitized video signals, wherein the DVR selection of digitized video signals can include one or more digitized video signals of the first selection of digitized video signals.

20. The method of claim 19, wherein c) is repeated by connecting additional DVRs to the network, whereby the digital video system is expanded to include at least one DVRC and a plurality of DVRs, each DVR having:

a plurality of DVR video-in ports, for receiving video signals from video cameras;

a DVR network port;

wherein each DVR is adapted to transmit through its DVR network port a DVR selection of digitized video signals, wherein each DVR selection of digitized video signals can include one or more digitized video signals of the first selection of digitized video signals; and

wherein the first DVRC transmits through the network a control signal to one or more of the plurality of DVRs.

EVIDENCE APPENDIX

In the present application, there has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132, or other evidence entered by the Examiner and relied upon by Appellants in the present appeal.

RELATED PROCEEDINGS APPENDIX

No appeal or interference which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal is known to exist.